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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/707,834 | 01/15/2004 | Jim Bumgardner | PD 1321.02 US | 1833 |

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DVA / PIONEER DIGITAL TECHNOLOGIES
SUITE 200
2355 MAIN STREET
IRVINE, CA 92614

EXAMINER

VENT, JAMIE J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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2616

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/707,834 | | BUMGARDNER ET AL. | |
| | Examiner | | Art Unit | |
| | Jamie Vent | | 2616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's arguments filed November 11, 2004 have been fully considered but they are not persuasive.

On pages 11-13 applicant has argued that Knudson et al fails to each, disclose, or suggest the limitation of "receiving instructions to transfer one or more timeslots including a user extended lead timeslot or a user extended lead timeslot or a user extended trail timeslot" as disclosed in Claims 1, 8, and 15. It is shown in Figures 3 element 72 and 74 the system prompting the user to make a decision on a conflict. When the user the system does not enter a decision will automatically extend the timeslots as further seen in Figure 4. Furthermore, it is shown in the system that the system contains a VCR wherein it is well known in the art that recording sessions in a VCR has the capability of being manually set by a user. Thereby letting the user decide the timeslot of the program and therefore can make either a user extended lead or trail timeslot depending on preference of the user. For example if recording a 3:00pm-4:00pm show the user can select the recording time to start at 2:57pm – 4:05pm to insure that the program is recorded in its entirety. Therefore, the use of user extended lead or trail timeslots is met. Although, applicants points are understood the examiner can not agree. The rejection is maintained.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

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Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,760,583.

Claim 1 in the instant application corresponds to Claim 2 in U.S. Patent No 6,760,583 with the additional limitations of:

- Receiving instructions to transfer one or more timeslots on one or more channels to said storage device, at least one of said timeslots including a user extended lead timeslot or a user extended trail timeslot.

It would have been obvious to modify Claim 2 in U.S. Patent No 6,760,583 to include this feature in order to have manually set timeslots for programming the recording device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1,2,3,4,5,6,8,9,10,11,12,13,15,16,17,18,19, and 20, are rejected under 35 U.S.C. 102(b) as being unpatentable by Knudson et al (US 6,141,488).

[claims 1, 8, & 15]

In regard to Claims 1, 8, and 15, Knudson et al discloses a video recorder which has a method for transferring a broadcast signal to a storage device with an additional computer program comprising:

- Receiving instructions to transfer one or more timeslots on one or more channels to said storage device, at least one of said timeslots including a user extended lead timeslot or a user extended trail timeslot (Figure 3 receives various instructions regarding various timeslots and channels from the user who receives information about the timeslots and channels from Figure 2. Furthermore, it is well known in the art that in the recording environment, such as a VCR, allows the user to manually set timeslots due to personal recording preferences. Thereby meeting the limitations of user extended trail and lead timeslots);
- Determining if said instructions cause a conflict (Figure 3 Element 70 a conflict is determined);
- Determining one or more solutions to said conflict (Figure 3 Elements 72, 74, and 76 are solutions to the conflict);
- Providing a user an opportunity to choose one of said solutions to said conflict (Figure 3 Element 72 and 74 allows user to choose solution to conflict); and
- Resolving said conflict automatically, if said user does not choose one of said solutions (Figure 3 Element 76 no response from user prompts system to automatically resolve conflict).

[claims 2, 9, & 16]

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In regard to Claims 2, 9, and 16, Knudson et al discloses a step of determining one or more solutions comprising:

- Determining first type for first timeslot (Figure 4 Channel 4 shows the first timeslot between 2:59 and 4:03); and
- Determining second type for a second timeslot (Figure 4 Channel 5 shows the second time slot between 4:03 and 5:03.)

[claims 3, 10, & 17]

In regard to Claims 3, 10, and 17, Knudson et al discloses the first type is an automatically extended time slot and said second type is not an automatically extended time slot, further comprising, choosing second type as having higher priority (Figure 4 Element 82 shows the buffer segment/automatically extended time slot while second type does not have a buffer segment/automatically extended time slot as seen in Element 84. Priority is given to the second type which is truly set to begin at 4:00, as seen in Figure 5, where priority of the first three minutes is given to the second timeslot that does not have a buffer segment/automatic extended time slot).

[claims 4, 11, & 18]

In regard to Claims 4, 11, and 18, Knudson et al discloses the first type is a user extended lead time slot and said second type is a core time slot, further comprising, choosing said second type as having higher priority (Figure 5 shows a user extended lead time in Element 90 while a core time slot is seen in Element 88. As seen in from Figure 4 to Figure 5 the core time slot has a higher priority over the user extended lead time slot, Element 90).

[claims 5, 12, & 19]

In regard to Claims 5, 12, and 19, Knudson et al discloses the first type is a user extended trail time slot less than a fixed interval and said second type is a core time slot, further comprising

choosing said second type as having higher priority (Column 7 Lines 45+ states when the one-minute buffer segments/user extended trail time slots allow for recording of the program in its entirety; however, it can cause the beginning of the second program's core time slot to be lost until the buffer is complete. As seen in Figure 5, the system eliminates the trailing buffer/user extended trail time slot of a fixed interval when recording consecutive programs in order to allow complete recording of the second type and giving the core time slot priority.)

[claims 6, 13, & 20]

In regard to Claims 6, 13, and 20, Knudson et al discloses that transferring a broadcast signal to a storage device further comprises:

- Obtaining and examining each timeslot (Figure 7a Element 102);
- Establishing cumulative priority for each of said solutions based on each timeslot (Figure 7a Element 104); and
- Determining and choosing one or two lowest priority solutions to said conflict based on cumulative priority and present to user (Figure 7a Elements 106 and 108).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al (US 6,141,488) in view of Barton et al (US 6,233,389).

[claims 7, 14, & 21]

In regard to Claims 7, 14, and 21, Knudson et al discloses a step of determining if said instructions cause a conflict comprises:

- Determining a second number of timeslots to be transferred to said storage device (Figure 3 receives various instructions regarding various timeslots and channels from the user who receives information about the timeslots and channels from Figure 2 thereby determining additional timeslots to be transferred to the storage device as described in Column 7 Lines 40+);
- Determining a conflict exists if said first number is less than said second number (Figure 4 shows a conflict in recording between channel 4 and 5. It is determined that the first program Figure 4 element 82 has less priority (a lesser number) over element 84 therefore, allowing the second program to record the entire program as seen in Figure 5 elements 86 and 88 and described in Column 7 Lines 58-67 and Column 8 Lines 1-5);

However, lacks to disclose a method of determining a first number of tuners available in the system. Barton et al discloses a scheduling system incorporating multiple inputs as seen in Figure 2 elements 201-204. As further described in Column 4 Lines 15-23 it is determined how many multiple input sections (tuners) are present in the system by the media switch 205. By incorporating multiple tuners allow for the capability of recording multiple programs from multiple channels at the same program time.

Therefore, it would be obvious to one skilled in the art at the time of the invention to have a storage device with conflict resolution of programming of channels, as disclosed by Knudson et al, and incorporate a system which has a multiple inputs (tuners), as disclosed by Barton et al.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 571-272-7375. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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